

**R E M A R K S**

Attention is respectfully directed to the attached terminal disclaimer. The requisite disclaimer fee is being submitted herewith.

Claims 10, 13 and 21 have been again amended in response to the rejection under 35 U.S.C. §112, second paragraph. Since this Amendment does not increase either the total number of claims or the number of independent claims, no additional fee is necessary.

Claims 1 - 6, 8 - 22, 30, and 32 - 40 are in the application. Claims 8, 30 and 39 have been allowed, and claim 21 has been indicated to be allowable if rewritten to overcome the rejection under §112, second paragraph (note that claim 21 has already been rewritten in independent form to include all the limitations of claim 13). All the other claims have been rejected.

**New Matter**

The requirement for cancellation of the paragraph added to the specification at p. 56 by applicants' last previous Amendment is noted. It is respectfully submitted, however, that the Examiner is in error in holding that the added paragraph introduces new matter. Reconsideration and withdrawal of the requirement for cancellation of the added paragraph are requested for the following reasons:

The description of the ingredients, relative proportions and procedure for preparation of each one of the toners of the Examples and Comparative Examples of the present specification is sufficiently complete so that a person skilled in the art, following such description, would certainly produce a toner having

essentially the same saturation magnetization (determined at a magnetic field of 10 kOe) as the saturation magnetization value given for that toner in the specification.<sup>1</sup> That is to say, a particular value of saturation magnetization (determined at a magnetic field of 10 kOe) is an inherent and reproducible property of each specific toner described in the Examples and Comparative Examples of applicants' specification. For instance, a saturation magnetization of 15.2 emu/g determined at a magnetic field of 10 kOe is an inherent property of the toner described in Example 1 of the specification.

An inherent property of a particular material is disclosed by necessary implication in any description of the material that is sufficiently complete so that every material meeting the description will have the property, even if the description does not expressly mention the property, because a material and its inherent properties are inseparable. Consequently, an amendment that merely adds to such a description (in a specification of a patent application) an express mention of a previously-unmentioned inherent property of the described material does not introduce new matter. *Ex parte Doushkess*, 47 U.S.P.Q. 525 (Pat. Off. Bd. App. 1940); *see Kennecott Corp. v. Kyocera International Inc.*, 5 U.S.P.Q.2d 1194, 1197-98 (Fed. Cir. 1987) (express description of inherent property is not new matter).

It follows that if the present specification had wholly failed to disclose any saturation magnetization property of the toner of Example 1, an amendment adding to the description a

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<sup>1</sup>The saturation magnetization changes depending on the magnetic field at which the saturation magnetization is measured. However, when the magnetic field is not less than about 5 kOe, the saturation magnetization is almost the same for different values of magnetic field although the profile of the magnetization curve is different.

statement that "The toner has a saturation magnetization of 15.2 emu/g determined at a magnetic field of 10 kOe" would not introduce new matter.

In fact the description of Example 1, in the specification as originally filed, set forth the saturation magnetization of the described toner as being 15.2 emu/g but omitted to give the magnetic field at which that value was determined. Insofar as that omission rendered the express disclosure of the relevant property incomplete, the property was nevertheless implicitly disclosed in the original specification by the detailed description of a specific material (toner) in which it is inherent. Hence, an amendment adding to the specification a statement that the saturation magnetization of the toner in Example 1 was determined at a magnetic field of 10 kOe simply constitutes an express description of a property inherent in an already disclosed specific material, and as such, does not introduce new matter.

What has been said above with reference to the toner of Example 1 of applicants' specification is equally true of all the toners of the other Examples and Comparative Examples of the specification; each of these toners is described in comparable detail, and for each of them a value of saturation magnetization (omitting mention of the magnetic field at which it was determined) is given in Table 1 at p. 75. The statement added by the last previous Amendment to p. 56 simply states that "All values of saturation magnetization of toners set forth in the following Examples and Comparative Examples were determined at a magnetic field of 10 kOe, and are, therefore, values of saturation magnetization at a magnetic field of 10 kOe." Consequently, it is merely an express description of a property inherent in specific

materials already specifically and reproducibly disclosed and, as such, does not introduce new matter.

The Examiner's holding of new matter is predicated on the assertion that "determining the toner saturation magnetization in a magnetic field of '10 kOe' **would not have been obvious** to a person having ordinary skill in the art" (Office Action mailed 10/27/2003, p. 4; emphasis added). Applicants respectfully submit that nonobviousness is not the test of new matter under the authorities cited above. Rather, the test is whether the property expressly described in the amendatory language is **inherent** in the material or composition of matter that was originally disclosed: if it is inherent, there is no new matter.

The Examiner also observes that the previously submitted Rule 132 Declaration "is not part of the originally filed specification." To be sure, it is not. But the purpose of the Rule 132 Declaration was to provide a showing that the property in question (saturation magnetization determined at a magnetic field of 10 kOe) was inherent in the originally disclosed toners of the Examples and Comparative Examples of the specification; and a Rule 132 Declaration is clearly proper for that purpose. The above-cited decisions, holding that an amendment expressly describing an inherent property of an initially disclosed material is not new matter, necessarily address the situation where the inherent property is not mentioned in the original specification. In that situation, express information about the inherent property can only be supplied by a submission extrinsic to the original application. A Rule 132 Declaration is an appropriate vehicle for such a submission. The initial omission of express disclosure of the inherent property does not mean that the application is not complete as filed.

**Section 112, Second Paragraph**

In response to the rejection of claims 10 - 22 under 35 U.S.C. §112, second paragraph, as indefinite, the independent claims (10, 13 and 21) of this group have been amended by replacing the language

"changing addition of additional toner to said two-component developer on the developer bearing member by changing a state of contact of said two-component developer on said developer bearing member with said additional toner"

with

"changing addition of additional toner to said two-component developer on the developer bearing member by preventing or permitting supply of additional toner to said two-component developer on said developer bearing member . . . ."

It is understood, from the discussion of the rejection in the Office Action, that the expression considered indefinite in these claims was "changing a state of contact." That language has now been deleted; the substituted recital, "preventing or permitting supply of additional toner," is believed to be properly supported by the disclosure of the specification, and adequately clear and definite to overcome the rejection as to all of claims 10 - 22.

Incidentally, the statement (Office Action, p. 8) that "Applicants cannot read limitations from the specification into the claims" is queried. As a general rule of claim construction, a court cannot read limitations from the specification into the claims; but the quoted statement appears inconsistent with the principles that a patentee may be his own lexicographer and that claims may be construed in light of meanings given to claim terms by applicants during prosecution.

### **Section 112, First Paragraph**

The rejection of claims 1 - 6, 9, 20 and 38 under 35 U.S.C. §112, first paragraph, for lack of adequate written description of the saturation magnetization, is predicated on the above-discussed requirement for cancellation of the paragraph previously added by amendment to the specification at p. 56.

As explained above, the amendatory paragraph in question did not introduce new matter, and therefore should not have to be canceled, because it merely expressly describes a property inherent in materials (toners of the Examples and Comparative Examples) already specifically disclosed in the original application. The inherent property is saturation magnetization determined at a magnetic field of 10 kOe. This subject matter was implicitly described in the specification "in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention," i.e., by virtue of the original descriptions of the specific toners (ingredients, proportions, method of preparation) in which the property is inherent.

It is well settled that the requirement of §112, first paragraph, for a written description may be satisfied by amendment of the specification during prosecution, provided that (as here) no new matter is introduced. The paragraph added by amendment at p. 56, introducing no new matter, establishes that saturation magnetization values in the present application are values determined at a magnetic field of 10 kOe, and, applicants submit, thereby satisfies the written description requirement for the magnetic field recitals previously added to independent claims 1, 20 and 38.

### **Section 103(a)**

Claims 1 - 3, 5, 6 and 32 - 38 have been rejected under 35 U.S.C. §103(a) as unpatentable over Asanae et al. '699 in view of EP '507. These claims (and all other claims rejected on prior art) are limited, *inter alia*, to a two-component developer comprising a magnetic carrier and a toner for developing a latent electrostatic image to a toner image, wherein the toner comprises a binder resin and a magnetic material which is blackened by coating the surface of a magnetic powder with a coloring agent.

Asanae et al. '699 is directed to a two-component developer comprising a magnetic carrier and a toner which comprises a binder resin and magnetic powder, but, as the Office Action acknowledges, Asanae et al. '699 does not disclose the use of magnetic material (magnetic powder) coated with a coloring agent. EP '507 is cited as disclosing a magnetic toner comprising a binder resin and black magnetic composite particles comprising magnetite particles surface-coated with carbon black for use as a one-component developer but (as the Office Action also recognizes), it does not teach that its magnetic toner could be used in a two-component developer with a magnetic carrier.

At issue is whether it would have been obvious to use the magnetic toner of EP '507 as the toner of the two-component developer of Asanae et al. '699, as the Examiner asserts.

With reference to this ground of rejection, it may initially be noted that one-component developers include a magnetic material to obtain a magnetic attraction force from a magnetic sleeve to be held thereon. In contrast, two-component developers are held on a carrier by an electrostatic force, while the carrier is held on a magnetic sleeve by the magnetic attraction force. Therefore, when

a one-component developer, which typically has a high saturation magnetization, is used as the toner in a two-component developer, the one-component developer receives a strong attraction force from a magnet contained in a developing sleeve as well as electrostatic force formed between a carrier and the developer, and thereby the one-component developer has poor developing ability, resulting in serious decrease of image density.

Consequently, applicants submit, it would not have been obvious to a person of ordinary skill in the art to use a magnetic toner designed for employment as a one-component developer, such as the toner of EP '507, as the toner of a two-component developer such as that described by Asanae et al. '699.

In contrast, the toner of the present invention includes a magnetic material as a colorant and has an appropriate saturation magnetization. Therefore, the toner is appropriately attracted by a magnetic sleeve, and thereby good images can be produced without causing background development in the resultant images and without decreasing image density. Namely, the saturation magnetization of the present invention is smaller than those of one-component developers. See p. 2, line 20 - p. 3, line 23; p. 14, line 16 - p. 15, line 11; and p. 17, lines 3-11, in applicants' specification.

The toner of the present invention has advantages in that good images can be produced without causing background development and toner scattering. The toner of EP '507 has advantages of having high fluidity and blackness (as described in the specification of EP '507). When the fluidity is improved the uniformity of images is improved, and when blackness is improved, the image density is improved. The advantages of both toners relate to image quantities, but the targeted image qualities are different.

Applicants therefore further submit that the recitals of a two-component developer comprising a magnetic carrier and a toner for developing a latent electrostatic image to a toner image, wherein the toner comprises a binder resin and a magnetic material which is blackened by coating the surface of a magnetic powder with a coloring agent, distinguish claims 1 - 3, 5, 6 and 32 - 38 patentably over Asanae et al. '699 and EP '507, considered together, because it would not have been obvious to combine their teachings as the Examiner asserts.

No statement of any ground of rejection of claim 4 on prior art is noted in the Office Action. It is submitted that claim 4 distinguishes patentably over the references in the same manner as claim 1, on which it depends. Compare the rejection of claim 35 (discussed above), which sets forth the same specific limitation as claim 4.

Claims 9 and 40, respectively dependent on claims 1 and 32 (discussed above), are rejected as unpatentable over Asanae et al. '699 and EP '507, further in view of Asanae et al. '289, which is cited for the particle size limitation recited in these dependent claims. Asanae et al. '289 does not supply what is lacking in Asanae et al. '699 and EP '507 respecting the obviousness of combining their teachings as the Examiner asserts. Hence, claims 9 and 40 are submitted to distinguish over the applied references in the same manner as claims 1 and 32.

Claims 10 - 20 are rejected as unpatentable over Asanae et al. '699 and EP '507, further in view of Oka, which is cited for the developing unit. In the rejection of claim 22, dependent on 13, the Examiner has also applied Asanae et al. '289 for the particle size feature. The two independent claims in this group (10 and 13) set forth the same limitations as claim 32 (discussed

above) respecting the two-component developer, and coated magnetic powder, and distinguish in like manner over Asanae et al. '699 and EP '507. Neither Asanae '289 nor Oka adds anything thereto with respect to this combination of features. Hence, all of claims 10 - 20 and 22 are submitted to distinguish patentably over the applied references, considered together.

***Nonobviousness Type Double Patenting***

In response to the nonobviousness type double patenting rejection, a terminal disclaimer and fee are submitted herewith. This submission fully overcomes the stated rejection.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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